

Appl. No. 09/762,991
Reply to Office Action of May 31, 2005

Attorney Docket No. RR2606 (22171.240)
Customer No. 27683

REMARKS

Claims 4, 6-12 and 14-21 are present in the application. In view of the remarks that follow, Applicants respectfully request reconsideration of the application.

Allowable Subject Matter

Noted with appreciation is the indication in the Office Action that Claims 9, 12, 14 and 16-21 have been allowed.

Premature Finality

Applicants respectfully traverse the finality of the Office Action. More specifically, MPEP 706.07(a) specifies that an Office Action shall not be final:

where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

The remarks of Applicants' last Response pointed out that the basis for the §112 rejection in the prior Office Action was not clear. The §112 rejection as set forth on pages 2-3 of the present Office Action is a direct copy of text from the §112 rejection in the prior Office Action. Then, on pages 4-5, the present Office Action offers more than a page of new text that basically seeks to fill in the gaps and defects in the §112 rejection as presented on pages 2-3. The text on pages 4-5 goes well beyond the boundaries of the original rejection, and raises new §112 issues that were not encompassed by the original rejection. (For example, in lines 3-6 on page 5, the Office Action discusses a constantly changing "environment", which raises issues that were not even

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remotely encompassed by the original §112 rejection). Considering the Office Action as a whole, the §112 rejection constitutes not only the material with gaps and defects on pages 2-3, but also the material on pages 4-5 that seeks to cure the gaps and defects, and that raises new issues. The new issues constitute new grounds of rejection that were not necessitated by any amendment or by any information submitted in an information disclosure statement. Accordingly, pursuant to MPEP §706.07(a), these new grounds of rejection under §112 prevent the present Office Action from properly being designated as a final rejection. It is therefore respectfully submitted that the finality of the Office Action is not proper, and must be withdrawn.

Second Paragraph of 35 U.S.C. §112 – Claims 4 and 15

The Office Action rejected Claims 4 and 15 as indefinite under the second paragraph of 35 U.S.C. §112. On page 4, the Office Action explains the asserted problem in Claim 4 with the following question:

If “no ARQ block includes any tail bits”, how can “physical layer frame includes multiple tail bits” when the “physical layer frame” includes the [sic] “the ARQ block”.

The simple answer to this question is that although Claim 4 specifies that the physical layer frame includes ARQ blocks, Claim 4 does not specify that the physical layer frame includes only ARQ blocks. The recited tail bits can be in a portion of the physical layer frame other than the ARQ blocks.

Turning to Claim 15, page 4 of the Office Action explains the asserted problem in Claim 15 with the following question:

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Turning to Claim 15, page 4 of the Office Action explains the asserted problem in Claim 15 with the following question:

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Same reasoning for Claim 15, how can the "overhead bits . . . no tail bits" when "frame structure" includes the overhead bits with appended tail bits.

The simple answer to this question is that Claim 15 recites that the frame structure includes overhead bits, that the overhead bits include CRC bits, and that tail bits are appended to the frame structure. That is, the overhead bits can be within the frame structure, and the tail bits can be external of and appended to the frame structure. There is no inconsistency in these limitations from Claim 15.

For these reasons, it is respectfully submitted that Claims 4 and 15 are entirely definite and in full compliance with the second paragraph of §112, and notice to that effect is respectfully requested.

Second Paragraph of 35 U.S.C. §112 – Claims 7, 10 and 11

The Office Action rejected Claims 7, 10 and 11 under the second paragraph of 35 U.S.C. §112 as indefinite. In a recent prior Office Action, the Examiner asserted that these claims recite certain functions, but that they do not recite structure for performing these functions, which are the functions of being "responsive to the environment for producing a relatively high throughput" in Claim 7, being "modifiable to balance requirements for data transmission and voice transmission" in Claim 10, and being "modifiable to promote efficient operation depending on a wireless environment" in Claim 11. In reply, the remarks of Applicants' last Response pointed out that Claims 7, 10 and 11 each recite "a node" that performs the respective function.

In the paragraph that bridges pages 4-5, the present Office Action states that Claims 7, 10 and 11 each recite that the "node" performs the function of transmitting wireless signals, and then asserts that, if Applicants are correct, these claims are each improperly specifying that the recited "node" performs two different functions. There are two problems with the Examiner's assertion. The first problem is that the recited functions in each claim are not separate and

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Same reasoning for Claim 15, how can the "overhead bits . . . no tail bits" when "frame structure" includes the overhead bits with appended tail bits.

The simple answer to this question is that Claim 15 recites that the frame structure includes overhead bits, that the overhead bits include CRC bits, and that tail bits are appended to the frame structure. That is, the overhead bits can be within the frame structure, and the tail bits can be external of and appended to the frame structure. There is no inconsistency in these limitations from Claim 15.

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independent functions. In particular, in Claim 7, the function of being "responsive to the environment for producing a relatively high throughput" is part of the recited function of transmitting wireless signals. In Claim 10, the function of being "modifiable to balance requirements for data transmission and voice transmission" is part of the recited function of transmitting wireless signals. In Claim 11, the function of being "modifiable to promote efficient operation depending on a wireless environment" is part of the recited function of transmitting wireless signals. The second problem with the Examiner's position is that, even if the two functions in each claim did happen to be separate and independent functions, there is no rule preventing a claim from reciting that a single element performs two functions. In fact, if a single element performed two different functions, and if a claim attempted to recite a first element for performing one function and a second element for performing the other function (as proposed by the Examiner), then the claim would be improper under MPEP §2173.05(o) for double inclusion.

Still referring to the limitations "responsive to the environment for producing a relatively high throughput" in Claim 7, "modifiable to balance requirements for data transmission and voice transmission" in Claim 10, and "modifiable to promote efficient operation depending on a wireless environment" in Claim 11, the paragraph bridging pages 4-5 of the Office Action asserts that these limitations are:

mere functional limitations because it [sic] defines something by
what it does rather than by what it is (e.g. by its specific structure).
see MPEP 2173.05(g).

Apparently, the Examiner believes that it is not proper for these claims to use a functional limitation to define the recited node by what it does. However, the Examiner's position is contrary to law, and also contrary to the PTO's position. More specifically, the Examiner cites language from MPEP 2173.05(g), but the Examiner takes that language out of context, because

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MPEP §2173.05(g) actually supports Applicants' position. In particular, the provisions of MPEP §2173.05(g) state that:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. . . .

In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as "members adapted to be positioned" and "portions . . . being resiliently dilatable whereby said housing may be slidably positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. *In re Venezia*, 530 F.2d 936, 189 USPQ 149 (CCPA 1976).

In other words, the PTO's official position is that a process limitation or functional limitation can in fact be used to properly define structure of an apparatus. This is precisely what Applicants have done in the functional limitations used in Claims 7, 10 and 11. It is therefore respectfully submitted that there is nothing improper or indefinite with Applicants' use of functional language to define structure in Claims 7, 10 and 11.

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In the paragraph that bridges pages 4-5, the Office Action also asserts that the indicated functional language in Claims 7, 10 and 11 is indefinite because it sets no boundaries, in that a recited "environment" is always changing. However, Claim 10 does not mention an "environment", and the assertion is thus meaningless as to Claim 10. As to Claims 7 and 11, and even assuming that an environment is constantly changing, there is no clear indication in the Office Action of why a changing environment might possibly render these claims indefinite. Claims to electrical circuits often recite that the circuit is responsive to an input signal (from some environment), and while the input signal can be constantly changing, that does not mean that the claimed circuit is indefinite. It is respectfully submitted that the reference to an "environment" in Claims 7 and 11 does not automatically render these claims indefinite. If the Examiner believes that there is a valid problem associated with use of the word "environment" in either of Claims 7 and 11, the Examiner should issue a further Office Action with a new ground of rejection that explains in significantly more detail why Claims 7 and 11 might possibly be considered indefinite if the recited "environment" happens to change.

For the various different reasons discussed above, it is respectfully submitted that Claims 7, 10 and 11 are entirely definite and are in full compliance with the second paragraph of §112, and notice to that effect is respectfully requested.

Allowability of Claims 4, 6, 10-11 and 15

As discussed above, Claims 4, 6, 10-11 and 15 were rejected under §112. However, for reasons discussed above, Claims 4, 6, 10-11 and 15 are believed to be in compliance with §112. Therefore, and since these claims are not subject to any rejection on the merits, these claims are believed to be allowable, and notice to that effect is respectfully requested. On page 6, the Office Action specifically acknowledges that Claim 15 recites patentable subject matter, and it is respectfully submitted that the same is also true as to Claims 4, 6 and 10-11.

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Claims 7 and 16, and 35 U.S.C. §102

The Office Action rejects Claims 7 and 8 under 35 U.S.C. §102, on the ground that they are each anticipated by Jayapalan U.S. Patent No. 5,533,019. These grounds of rejection are respectfully traversed, for the following reasons. The PTO specifies in MPEP §2131 that, in order for a reference to anticipate a claim under §102, the reference must teach each and every element recited in the claim.

With respect to Claim 7, the Office Action notes that Claim 7 recites "a node of a spread spectrum wireless network", and then states that this limitation is deemed to be an indication of intended use and therefore will be given no patentable weight. To the extent the Examiner considers the words "spread spectrum" to be a statement of intended use that is not entitled to patentable weight, the Examiner is essentially saying that the words "spread spectrum" are superfluous and thus should never appear in any apparatus claim. Applicants respectfully disagree. In this regard, it is noted that Examiner Lee has previously examined and issued U.S. patents having claims that contain the words "spread spectrum", for example U.S. Patent Nos. 6,738,448 and 5,940,379. In fact, a brief search of the patent database at the U.S. Patent Office Web site shows that, over the past 30 years, the U.S. Patent Office has issued more than 2600 U.S. Patents that have claims containing the words "spread spectrum". Applicants respectfully submit that, in most or all of these 2600 patents, the words "spread spectrum" were not ignored on the theory they constitute a statement of intended use, but were properly given patentable weight.

Moreover, Applicants previously explained that the recitation of "a node of a spread spectrum wireless network" is an integral part of the body of Claim 7 and is in fact a recitation of structure, and therefore must be given patentable weight. On page 5 of the present Office Action, the Examiner replies by citing a *Pitney Bowes* court decision for the proposition that the words "spread spectrum" in Claim 7 can be ignored because:

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spread spectrum does not "give life, and meaning and vitality to a claim" because spread spectrum is not required in the body of the claim.

However, the *Pitney Bowes* decision does not apply to the present situation. In particular, the *Pitney Bowes* decision is discussed in MPEP §2111.02, and *Pitney Bowes* and MPEP §2111.02 both deal with the issue of whether language in a claim preamble should be given patentable weight. In Applicants' Claim 7, the preamble is "An apparatus comprising", and everything after that preamble constitutes the body of Claim 7, including the words "spread spectrum". While *Pitney Bowes* and MPEP §2111.02 allow an Examiner to ignore words in a preamble under certain circumstances, they do not allow an examiner to ignore any words in the body of a claim under any circumstances. Accordingly, it is respectfully submitted that the words "spread spectrum" in the body of Claim 7 must be taken into account. The Office Action also asserts that "spread spectrum wireless network" in Claim 7 is a recitation of an intended use. Applicants respectfully disagree. The recitation in Claim 7 of "a node of a spread spectrum wireless system" is a clear recitation of structure that is a part of the claimed "apparatus", rather than a statement of an intended use for the claimed apparatus. Consequently, this limitation cannot be ignored on the theory that it is a statement of intended use. The Office Action concedes on page 5 that Jayapalan does not teach a wireless system that is "spread spectrum". Therefore, Jayapalan does not anticipate Claim 7 under §102, because Jayapalan does not disclose each and every element recited in Claim 7, as required by MPEP §2131.

A different issue is that Claim 7 expressly recites that "the number of ARQ blocks is responsive to the environment for producing a relatively high throughput", and Claim 8 expressly recites that "the number of ARQ blocks is responsive to whether the information is voice or data". In regard to these limitations, the present Office Action asserts that:

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while [an] apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (See *In re Swinehart*, 169 USPQ 226 (CCPA 1971)).

This passage from the Office Action cites the court decision of *In re Swinehart* in support of the Examiner's position. However, the decision of *In re Swinehart* actually stands for the exact opposite of the Examiner's position. More specifically, the *Swinehart* case involved a situation where an examiner conceded that functional language in means-plus-function format was entitled to be given patentable weight, but the examiner asserted that he could ignore functional language that was not in means plus function format. The PTO backed the examiner, took the issue to court, and lost. In particular, the Court ruled that the examiner and the PTO were both wrong. Consequently, since the PTO is legally required to follow the *Swinehart* decision, the PTO now conforms to that view. For example, the PTO cites the *Swinehart* decision with favor in MPEP §2173.01, and states that:

Applicant may use functional language . . . or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the Court in *In Re Swinehart*, 439 F2d. 210, 169 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

Similarly, MPEP §2173.05(g) cites the *Swinehart* decision, and states that: "A functional limitation is an attempt to define something by what it does rather than what it is. . . . Functional language does not, in and of itself, render a claim improper". Moreover, MPEP §2114 states

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This passage from the Office Action cites the court decision of *In re Swinehart* in support of the Examiner's position. However, the decision of *In re Swinehart* actually stands for the exact opposite of the Examiner's position. More specifically, the *Swinehart* case involved a situation where an examiner conceded that functional language in means-plus-function format was entitled to be given patentable weight, but the examiner asserted that he could ignore functional language that was not in means plus function format. The PTO backed the examiner, took the issue to court, and lost. In particular, the Court ruled that the examiner and the PTO were both wrong. Consequently, since the PTO is legally required to follow the *Swinehart* decision, the PTO now conforms to that view. For example, the PTO cites the *Swinehart* decision with favor in MPEP §2173.01, and states that:

Applicant may use functional language . . . or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the Court in *In Re Swinehart*, 439 F2d. 210, 169 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

Similarly, MPEP §2173.05(g) cites the *Swinehart* decision, and states that: "A functional limitation is an attempt to define something by what it does rather than what it is. . . . Functional language does not, in and of itself, render a claim improper". Moreover, MPEP §2114 states

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that, in an apparatus claim, "features of an apparatus may be recited either structurally or functionally". Consequently, the Examiner's attempt to rely on *Swinehart* for the proposition that functional claim language can be ignored is directly opposite to what the Court actually ruled in *Swinehart*, because the Court decided that an examiner is not allowed to ignore any functional language. The PTO has officially accepted the Court's position. Therefore, although Claims 7 and 8 of the present application do contain some functional language, it is respectfully submitted that, under court decisions and PTO policy, this functional language must be given patentable weight. To the extent that the present Office Action completely ignored this functional language in each of Claims 7 and 8, and failed to give it any patentable weight, the Office Action takes a position that is contrary to court decisions and also contrary to well-established PTO policy.

Still referring to the recitation in Claim 7 that "the number of ARQ blocks is responsive to the environment for producing a relatively high throughput", and the recitation in Claim 8 that "the number of ARQ blocks is responsive to whether the information is voice or data", the Office Action asserts on page 5 that these limitations do not mean that the number of ARQ blocks is variable. Applicants respectfully disagree. It is respectfully submitted that a person of ordinary skill in the art will readily understand from these limitations that the number of ARQ blocks can vary based on a specified factor. In contrast, the Jayapalan patent only mentions "ARQ" twice, namely in the first few lines of column 7. This mention of ARQ in Jayapalan is vague and, as best understood, does not include any clear disclosure that the number of ARQ blocks can vary on the basis of some specific criteria, much less the specific criteria that is recited in Claim 7 or the specific criteria that is recited in Claim 8. Jayapalan thus does not appear to disclose each and every element recited in Claims 7 and 8, and therefore does not meet the requirement set forth in MPEP §2131. Accordingly, it is respectfully submitted that Jayapalan does not anticipate Claims 7 and 8 under §102, and notice to that effect is respectfully requested.

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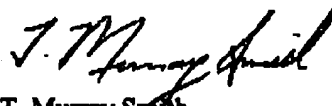
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Conclusion

Based on the foregoing, it is respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way by a telephone conference, the Examiner is invited to telephone the undersigned attorney at 972-739-8647.

Although Applicants believe that no additional fee is due, the Commissioner is hereby authorized to charge any fee required by this paper, or to credit any overpayment, to Deposit Account No. 08-1394 of Haynes and Boone, LLP.

Respectfully submitted,


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Enclosure: None

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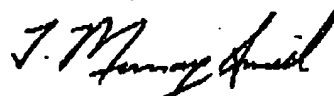
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